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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
HUYNH, CONG LAC T	
ART UNIT	**PAPER NUMBER**
2178	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/595,622	SIMONS, GEOFFREY W.	
	Examiner	Art Unit	
	Cong-Lac Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 13-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 13-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: RCE filed 3/15/05 to the application filed on 6/16/00, priority filed 6/16/99.

2. Claims 1-11, 13-35 are pending in the case. Claims 1, 11, 19, 26, 30 and 34 are independent claims.

3. The rejections of claims 19-24 under 35 USC 112, second paragraph, have been withdrawn in view of the amendment.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-11, 13-35 remain rejected under 35 U.S.C. 102(e) as being anticipated by Markus et al. (US Pat No. 6,490,601 B1, 12/3/02, filed 1/15/99).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding independent claim 1, Markus discloses:

- creating a user profile associated with a user, wherein said user profile includes user data (**figure 6, #604, #608**: retrieving user's raw data profile and merging user's raw data profile with mapping table inherently show that each of a plurality of user profiles are created and stored in memory so that the user data profiles including user data can be retrieved or used later)
- obtaining an electronic form having at least one field to be completed (**col 5, lines 1-12, 29-35**: "a form mapping containing a set of associations between *fields in the electronic form* ...", "...enabling automatic insertion of user information into *an electronic form having multiple fields* ...")
- dynamically generating a form map, wherein said form map identifies an association between user data and a field in the electronic form (**col 5, lines 1-55**: "*A form mapping containing a set of association between fields in the electronic form ... Each raw data file containing data strings, each data string corresponding to a pre-named field. Each raw data file is associated with a registered user ... The form mapping is utilized to attach a data string to the field in the electronic form where the pre-named field and the field in the electronic form have been previously matched or mapped ... a form mapping is utilized to attach a data string to the field in the electronic form ... comparing data relating*

to the field in the electronic form..."; since each user has different raw data file, generating such form map varies according to each user data file, said generating is performed dynamically according to each user; **col 14, line 30 to col 16, line 28**: *"... the user cookie is used to obtain the user's raw data, which includes actual data values and preferences associated with each data value. The practices mentioned above associated with legacy names and the preferences associated with user raw data values are stated in terms of conditions ...*"; mapping data into the form is performed according to the form map where the form map (or the form mapping) varies according to various conditions and preferences from each user inherently shows that the form map is generated dynamically according to various conditions and preferences from each user)

- obtaining the user profile from a fill server (**col 5, lines 29-41, 45-55**: "a *server* for enabling *automatic insertion of user information into an electronic form* having multiple fields ...*The server contains a memory area storing multiple raw data profiles* where each raw data profile corresponds to a registered user ...", "*the raw data profile includes several standard field names*, each standard field name having a corresponding data string and a use-preference data item determined by a registered user...")
- completing a field according to the form map of the electronic form with the user data upon the transfer of the user profile information to said field of the electronic form (**figure 4B, #440**: "Browser transmits *filled out electronic form document*"

inherently shows completing a field according to the form map for a field in the electronic form with the user data in the raw data file; **col 6, line 63 to col 7, line 23**: filling a form with data from the privacy bank shows transferring data from the user profile to a field of the electronic form)

Regarding claim 2, which is dependent on claim 1, Markus discloses that obtaining a user profile includes:

- transmitting a user identification and a signature of the electronic form to a fill server (**col 8, lines 1-14**: "User 302 informs privacy bank server 308 of the *identity of the user and of which Web site and which form on that Web site* (if more than one) the user wishes to have filled in. *This information is transmitted to privacy bank server* ...")
- obtaining the user profile from the fill server, wherein the user profile corresponds to the user identification (**col 8, lines 40-64**: the raw data profile storage area 328, one of the components of the privacy bank server which enables to fill in the electronic form on a remote user computer, includes the data profile for each registered user)

Regarding claim 3, which is dependent on claim 2, Markus discloses that the user identification includes a user ID and a user password (**col 8, lines 40-64**: "a registered user has an unique account that can be used as an identifier and a password...").

Regarding claim 4, which is dependent on claim 2, Markus discloses that the electronic form signature includes a text string having a uniform resource locator of the electronic form (**col 7, lines 40-62**: "a purchasing form, typically an HTML document, is returned and downloaded into and displayed in a browser window..."; the fact that the purchasing form is a HTML document inherently shows that the HTML document, which includes the electronic form, has an uniform resource locator; **col 11, lines 43-49:** the user identifier and the URL for identifying the document containing the form; **col 13, lines 38-48**: the identifier of the electronic form contains the identifier of the merchant's Web site in the form of a URL).

Regarding claim 5, which is dependent on claim 1, Markus discloses that the electronic form signature includes a descriptor of the one or more fields of the electronic form (**col 17, lines 8-15**: the name strings or field names or guides to entering data in an electronic form; **col 9, lines 1-13**: the field names are the descriptors of the fields in an electronic form).

Regarding claim 6, which is dependent on claim 4, Markus discloses that the electronic form signature includes a descriptor of form field requirements (**col 11, lines 39-49**: the fact that the URL which is used by the privacy bank server *to determine how the electronic form document should be filled* implies that said URL, which is the electronic form signature, contains a descriptor of form field requirements).

Regarding claim 7, which is dependent on claim 1, Markus discloses that the user profile is represented by a graphical icon on a display screen and wherein the user data is transferred to the electronic form on manipulation of the graphical icon within the display screen (**col 11, lines 15-22**: ".. by *clicking on the autofill button*, the user allows the browser to execute the shippable code or *profile stored thereon*...").

Regarding claim 8, which is dependent on claim 1, Markus discloses that the user profile includes shippable code embodying the user data corresponding to the fields of the electronic form, and wherein completing at least one of the fields of the electronic form includes executing the shippable code to complete at least one of the fields of the electronic form (col 5, lines 29-44).

Claims 9 and 10 are for a computer-readable medium and a computer system of any of method claims 1-8, and are rejected under the same rationale.

Regarding independent claim 11, Markus discloses:

- creating a user profile (**figure 6, #604, #608**: retrieving user's raw data profile and merging user's raw data profile with mapping table inherently show that each of a plurality of user profiles is created and stored in memory so that the user data profiles can be retrieved or used later)

- displaying of an electronic form having at least one field (**figure 3A, #316 and col 7, lines 41-62**: form 316 includes fields for filling data; **figure 4A, #402** Electronic form document with at least one field is loaded into browser)
- creating a form map of the fields for the electronic form wherein the form map is dynamically generated (**col 5, lines 1-55**: "*A form mapping containing a set of association between fields in the electronic form ... Each raw data file containing data strings, each data string corresponding to a pre-named field. Each raw data file is associated with a registered user ... The form mapping is utilized to attach a data string to the field in the electronic form where the pre-named field and the field in the electronic form have been previously matched or mapped ... a form mapping is utilized to attach a data string to the field in the electronic form ... comparing data relating to the field in the electronic form...*"; since each user has different raw data file, generating such form map varies according to each user data file, said generating is performed dynamically according to each user; **col 14, line 30 to col 16, line 28**: "*... the user cookie is used to obtain the user's raw data, which includes actual data values and preferences associated with each data value. The practices mentioned above associated with legacy names and the preferences associated with user raw data values are stated in terms of conditions ...*"; mapping data into the form is performed according to the form map where the form map (or the form mapping) varies according to various conditions and preferences from each user inherently shows that the form map is

generated dynamically according to various conditions and preferences from each user)

- displaying a second application indicative of the user profile containing data corresponding to at least one field of the electronic form according to the form map (**figure 4A, #408-418**: the fact that the browser for displaying the electronic form connects with the privacy bank and gets cookie and user data corresponding to the cookie from the privacy bank server inherently shows that the user profile data of the privacy bank server is displayed in a different window in a second application; **col 10, lines 1-35 and col 8, lines 19-39**)
- receiving a user selection indicative of the user device selecting one of said plurality of the user profile from a fill server (**col 7, lines 59-62:** the fact that user 302 can *"click" on a privacy bank icon or button* in form 316 where the privacy bank server contains the user profile shows an indication of user device selecting the user profile; **col 5, lines 29-41, 45-55**: "a *server* for enabling *automatic insertion of user information into an electronic form* having multiple fields ...*The server contains a memory area storing multiple raw data profiles* where each raw data profile corresponds to a registered user"; since the privacy bank server contains a plurality of user profiles, thus, selecting a user profile by clicking on the bank icon or button implies selecting one of said plurality of user profiles from the bank server)
- receiving a user selection indicative of the user device transferring the user profile from the second application to the first application (**figure 4A, #424**: the

fact that "User selects privacy bank autofill icon/button" indicates transferring user profile to the electronic form document via selecting the autofill button)

- completing at least one of the one or more of the fields of the electronic form (**col 7, lines 41-62 and figure 3A, #316**: "the process of automatic electronic form completion begins with a user downloading the form from a Web site ...user 302 can "click" on a privacy bank icon or button in form 316 and have the form automatically filled in"; **figure 4B, #440**: "Brower transmits filled out electronic form document" indicates that the form filling is complete before transmitting)

Regarding claim 13, which is dependent on claim 11, Markus discloses the user profile is a graphical icon displayed on a display screen (col 11, lines 15-30: clicking on the *autofill button*, the user allows executing the profile stored thereon).

Regarding claim 14, which is dependent on claim 11, Markus discloses that the user profile includes shippable code embodying the user data corresponding to the one or more fields and wherein completing the one or more fields of the electronic form includes executing the shippable code to complete at least one of the fields of the electronic form (**col 11, lines 15-25**: by clicking on the autofill button, the user allows the browser to execute the shippable code stored thereon; **col 11, lines 43-62, figures 4A-B**: the shippable code contains user data that allows the form document to be filled out automatically).

Regarding claims 15 and 16, which are dependent on claims 11 and 15 respectively, Markus discloses:

- the first application is displayed as a rectangular window in the graphical user interface (**figure 3A, #304 and figure 4A, #402**: browser for loading the electronic form having multiple fields in a rectangular window)
- the second application is displayed as a rectangular window in the graphical user interface (**figure 4A, #408, 410, 416, 418**: the fact that the browser for displaying the electronic form connects with the privacy bank and gets cookie and user data corresponding to cookie from the privacy bank server inherently shows that the user profile data of the privacy bank server is displayed in a different window, which is conventionally a rectangular window)

Claims 17 and 18 are for a computer-readable medium and a computer system of any of method claims 11-16, and are rejected under the same rationale.

Regarding independent claim 19, Markus discloses:

- obtaining a user identification corresponding to a user profile from a fill server, wherein the user profile is associated with a user (**col 8, lines 50-64**: the raw data profile storage contains *set of data relating to registered users* of the privacy bank service where each registered user has a unique account number as an identifier and a password for identification corresponding to his/her user profile in the bank server)

- obtaining a form signature of an electronic form having at least one field (**col 11, lines 43-49:** the electronic form document has an identifier such as a URL of the web site containing the form)
- dynamically generating a form map, wherein said form map identifies an association between user data and a field in the electronic form (**col 5, lines 1-55**: "*A form mapping containing a set of association between fields in the electronic form ... Each raw data file containing data strings, each data string corresponding to a pre-named field. Each raw data file is associated with a registered user ... The form mapping is utilized to attach a data string to the field in the electronic form where the pre-named field and the field in the electronic form have been previously matched or mapped ... a form mapping is utilized to attach a data string to the field in the electronic form ... comparing data relating to the field in the electronic form...*"; since each user has different raw data file, generating such form map varies according to each user data file, said generating is performed dynamically according to each user; **col 14, line 30 to col 16, line 28**: "*... the user cookie is used to obtain the user's raw data, which includes actual data values and preferences associated with each data value. The practices mentioned above associated with legacy names and the preferences associated with user raw data values are stated in terms of conditions ...*"; filling data into the form is performed according to the form map where the form map (or the form mapping) varies according to various conditions

and preferences from each user inherently shows that the form map is generated dynamically according to various conditions and preferences from each user)

- generating a fill bundle corresponding to a merger of data within at least one of the user profile and the form map corresponding to the form signature, wherein the fill bundle is embodied in a graphical representation (**figure 6, #608** Server merges mapping table with user's raw data profile, **#610** Server converts merger into shippable code and **col 13, line 49 to col 14, line 29**: generating a shippable code in the form of a JavaScript program where the shippable code, converted from the merger of legacy bank name and raw data value associated with one of a plurality of users, is used to fill in the form on the user browser; the shippable code bundles data for filing the electronic form, and is corresponding to a fill bundle)

Regarding claim 20, which is dependent on claim 19, Markus discloses obtaining the user profile corresponding to the user identification from a database having one or more user profiles organized according to a user identification (**figures 3A-B and col 8, lines 40-64**: raw data profile contains sets of data relating to registered user of the privacy bank service where a registered user has a unique account number as a user identification).

Regarding claim 21, which is dependent on claim 19, Markus discloses the form map corresponding to the form signature from a database having one or more maps organized according to a form signature (figure 7 and col 14, lines 30-52).

Regarding claim 22, which is dependent on claim 19, Markus discloses that if the form map database does not have a form map corresponding to the form signature, generating a form map based upon the form signature (**col 13, line 49 to col 14, line 4**: the privacy bank server uses the URL or other identifier for the specific form to be filled out to retrieve a mapping of each field name in the electronic form to privacy bank standardized names; the merchant submits one or more forms to privacy bank which then examines each field name in the forms and matches it with a privacy bank field name; the fact that if the legacy name does not match the privacy bank field names, then the privacy bank user raw data *can be updated to* include the legacy name based upon the identifier of the form indicates that when the privacy bank server whose form map database does not have the form map of the newly submitted form from the merchant, the privacy bank raw data *is updated to include the newly created form map of the new form based upon the corresponding URL or the form signatur*e).

Regarding claim 23, which is dependent on claim 19, Markus discloses that the fill bundle includes shippable code containing commands for completing one or more corresponding fields of the electronic form (**col 14, lines 5-29**: "normally browser programs have a JavaScript component that is manipulable by JavaScript commands.

These JavaScript commands in the shippable code are used to fill in the electronic form on the browser, a technique well known in the field of Internet and Java programming..").

Claims 24 and 25 are for a computer-readable medium and a computer system of any of claims 19-23, and are rejected under the same rationale.

Regarding independent claim 26, Markus discloses a computer system for completing electronic form comprising:

- a document browser operable to access and manipulate an electronic form having at least one field (**figure 3A, #316, figure 4A, #402** Electronic form document is loaded into browser, #404 Browser parses electronic form document content to identify external links)
- a map generator providing a form map of the at least one field (refer to the rejections of method claims 1 and 19 for the corresponding limitation "generating a form map ..."; since generating a form map is performed, a means for performing such limitation is inherently included in Markus)
- a fill server in communication with the document browser and providing a graphical representation of executable code embodying a plurality of user profiles including data for completing at least one of the fields of the electronic form (**figure 3A, #3 , #304** Document browser, # User profile data; **figure 4A, #422** Browser retrieves shippable code from privacy bank server, #424 User selects

privacy bank autofill icon/button; *the privacy bank server is where to create the fill bundle* which is the shippable code for filling data in the form from a remote user computer, is considered as a fill server; the privacy bank server in communication with the document browser in a graphical representation that has an autofill button for executing the filling process; since there is a plurality of user profiles in the bank server, the process will happen on a plurality of user profiles)

Regarding claim 27, which is dependent on claim 26, Markus discloses that the system further comprises a user information server in communication with the fill server and providing user profile data to the fill server (**col 7, line 63 to col 8, line 39**: the fact that the Markus system has the capability of providing user profile data and creating fill bundle embodied in shippable code for filling data in the user profile to electronic forms in a remote computer inherently shows that the Markus system includes a user information server in communication with the fill server).

Regarding claim 28, which is dependent on claim 26, Markus discloses a form map server in communication with the fill server and providing form maps corresponding to one or more fields of an electronic form, wherein the graphical representation includes a merger of a form map and user profile data (**figure 6 and col 13, line 49 to col 14, line 29**: the merger of mapping table, including form map, with user's raw data profile in a user's browser shows that the graphical representation of the browser window includes the merger; the mapping table retrieved from the privacy bank database connected to

the user's browser where to display the form and the web site that contains the form and to fill in the form inherently shows that the privacy bank database which stores the table of form mapping is considered as a form map server, and the privacy bank server is where to create the fill bundle embodied in shippable code is considered as the fill server).

Regarding claim 29, which is dependent on claim 19, Markus discloses a document served, in communication with the document browser and providing the electronic form having one or more fields (figure 6, #602 Privacy bank server retrieves user cookie and electronic form document identifier from browser, it was obvious an electronic form has one or more fields).

Claims 30-33 are for a computer readable medium of method claims 19-23, and are rejected under the same rationale.

Claims 34-35 are for a computer readable medium of method claim 14, and are rejected under the same rationale.

Response to Arguments

6. Applicant's arguments filed 3/15/05 have been fully considered but they are not persuasive.

Applicants argue that Markus does not disclose an automated map generator wherein form maps are dynamically created, and as such does not disclose or suggest "dynamically generating a form map, wherein said form map identifies an association between user data and a field in the electronic form" as similarly recited by amended independent claims 1, 11, 19, 30 and 34 (Remarks, page 8).

Examiner respectfully disagrees.

Markus discloses that the "form mapping containing *a set of association between fields in the electronic form ("non-standard fields") and pre-named fields ("standard fields") on the personal information server is retrieved. Each mapping is associated with a registered electronic form. A raw data file containing data strings, each data string corresponding to a pre-named field is retrieved. Each raw data file is associated with a registered user. The form mapping is utilized to attach a data string to the field in the electronic form where the pre-named field and the field in the electronic form have been previously matched and mapped*" (abstract, col 5, lines 1-55).

Markus also discloses that filling data into the form is performed according to the form map where the form map (or the form mapping) varies according to various conditions and preferences from each user (col 14, line 30 to col 16, line 28: *"... the user cookie is used to obtain the user's raw data, which includes actual data values and preferences associated with each data value. The practices mentioned above associated with legacy names and the preferences associated with user raw data values are stated in terms of conditions ...*")

The fact that the form mapping varies according to various conditions and preferences associated with different data file of each user inherently shows that the form mapping is generated dynamically dependent to the conditions and the preferences provided by each user. Further, since Markus shows "dynamically generating a form map, wherein said form map identifies an association between user data and a field in the electronic form", Markus, of course, includes a means equivalent to a map generator for dynamically generating said form map as claimed.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gupta et al. (US Pat No. 6,199,079 B1, 3/6/01, filed 3/20/98).

Milsted et al. (US Pat No. 6,345,256 B1, 2/5/02, filed 12/1/98, priority 10/22/98).

Pennell et al. (US Pat App Pub No 2002/0013788 A1, 1/31/02, filed 5/18/01, priority 11/10/98).

Maret et al., Multimedia Information Interchange : Web Forms Meet Data Servers, IEEE 1999, pages 499-505.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cong-Lac Huynh
Examiner
Art Unit 2178
04/12/05